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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,153	04/24/2000	Charles C. Brackett	15UL-5584	7268

23566 7590 04/05/2004

OSTRAGER CHONG & FLAHERTY LLP
825 THIRD AVE
30TH FLOOR
NEW YORK, NY 10022-7519

EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,153

Applicant(s)

BRACKETT, CHARLES C.

Examiner

Vanel Frenel

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed 01/12/04. Claims 31-35 have been cancelled. Claims 19-30 are pending.

Response to Arguments

2. Applicant's arguments filed 01/12/04 regarding claims 19-30 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 01/12/04.

(A) At pages 6-8 of the response, Applicant's argues the followings:

(1) Neither of these functions is disclosed in either Teshima or Koritzinsky such as: (a) inserting a new exam description (contained in the Edit field) into the list, both the list and the Edit field being displayed on the second screen; and (b) filling an Exam Description field on an updated version of the first screen with an exam description selected from the linked list by the system operator.

(2) Koritzinsky does not disclose any of the recited features.

(3) Koritzinsky is silent concerning selecting an entry on the list of protocols for display in an Exam Description field on a different screen.

(4) The obviousness rejection based on Koritzinsky is mistaken.

(B) With respect to Applicant's first argument, Examiner respectfully submits Teshima suggests "each consultation record including information of examinations,

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information of examination-related images, information of physical checkups, and biological information is described in SGML or HTML and contained in a data file. For storing the consultation record in the patient card, a specified group of files is not stored in the patient card, but link information is converted or produced so that the group of files can be referenced as external information, and then the consultation record is stored in the patient card. On the other hand, for reading a consultation record from the patient card and displaying it, the contents of an intended file are referenced according to link information, or an intended file is acquired on the basis of the link information and the contents of the file are displayed together with or separately from the consultation record" which correspond to Applicant's claimed feature (See Teshima, Col.3, lines 36-52). Therefore, Applicant's argument is not persuasive.

(C) With respect to Applicant's second argument, Examiner respectfully suggests that Teshima discloses selecting an exam description from a stored list of exam descriptions which is corresponding to "the patient's main complaint and the observed physical findings are entered. If necessary, an order is placed for an examination or medication. Otherwise, while a treatment is undertaken, the contents of a therapy are entered. If necessary, the results of past consultation records and periodical physical checkups are listed. The results of a consultation record and periodical physical checkup which may have relation are selected and displayed. The Examiner interprets such feature as Applicant's claimed limitation (See Teshima, Col.4, lines 1-67).

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(D) With respect to Applicant's third and fourth arguments, Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443,1444 (Fed. Cir. 1992), *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745F. 2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Using this standard, the Examiner, respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 17).

Rather, Applicant does not point to any specific distinction (s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111 (b) states, "A general allegation that the claim define a patentable invention without pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section". Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references.

Also, arguments or conclusions of Attorney cannot take place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1940); *In re Schulze*, 52 CCPA

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1422,346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make motivations must be articulated, it is respectfully contended that there is no requirement that the motivation to make motivations must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one of ordinary skill in the art at the time of the invention that support a holding of obviousness has been adequately provided by motivations and reasons indicated by the Examiner both in the present Office Action as well as the prior Office Action, *Ex parte Levengood*, 28 USPQ2D 1300 (Bd. Pat. App. & Inter., 4/22/93).

In response, all of the limitations which Applicant disputes as missing in the applied references of the 01/12/04 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Teshima, and /or Koritzinsky, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 17), and incorporated herein. One cannot show

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nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches an electronic medical records system (5,924,074), peripheral ultrasound imaging system (6,440,071) and computer-based medical image distribution system and method (6,260,021).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952.

The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F

March 26, 2004

Alexander K. Kinner
 Alexander Kinner
 BU 3626
 Raimund Kinner